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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,323	12/13/2001	Randal D. Schafer	840070.404	2929

500 7590 03/19/2004

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EXAMINER

GONZALEZ, MADELINE

ART UNIT PAPER NUMBER

2859

DATE MAILED: 03/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/015,323		SCHAFFER, RANDAL D.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Madeline Gonzalez		2859	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 May 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

In response to applicant's amendment dated January 26, 2004

### *Claim Objections*

1. Claim 7 is objected to because of the following informalities:
  - a) Claim 7: --of-- should be added after "method" in line 1.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 3-5 are rejected under 35 U.S.C. 102(b) as being anticipated by McEligot (U.S. 5,829,150).

McEligot discloses a tool 10, as shown in Fig. 1, having:

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- a transparent sheet of rigid material 12 having first and second opposing planar sides and a plurality of lines 22 formed on one of the first and second opposing planar sides;
- a sheet of non-static cling flexible material 14 sized and shaped to cover only the entire first side 18 of the sheet of rigid material 12, the sheet of flexible material 14 adhering to the first side 18 of the sheet of rigid material 12 by surface adhesion only and configured to provide a removable, planar, non-slip surface and to leave no adhesive on the first side 18 of the sheet of rigid material 12 when removed therefrom (see column 7, lines 36-39);
- wherein the sheet of flexible material 14 comprises a plurality of sheet segments placed together on the first side 18 of the sheet of rigid material 12; and
- wherein the plurality of lines 22 are formed on the first side 18 of the sheet of rigid material 12.

4. Claims 3 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by McEligot (U.S. 5,829,150).

McEligot discloses a tool 10, as shown in Fig. 1, having:

- a transparent sheet of rigid material 12 having first and second opposing planar sides and a plurality of lines 22 formed on one of the first and second opposing planar sides;

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- a sheet of non-static cling flexible material 14 sized and shaped to cover only the entire first side 16 of the sheet of rigid material 12 (see column 7, lines 31-35), the sheet of flexible material 14 adhering to the first side 16 of the sheet of rigid material 12 by surface adhesion only and configured to provide a removable, planar, non-slip surface and to leave no adhesive on the first side 16 of the sheet of rigid material 12 when removed therefrom; and
- wherein the plurality of lines 22 are formed on the second side 18 of the sheet of rigid material 12.

*Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over McEligot (U.S. 5,829,150) in view of Reber et al. (U.S. 5,557,996) [hereinafter Reber].

McEligot discloses a tool 10, as shown in Fig. 1, having:

- a transparent sheet of rigid material 12 having a plurality of lines 22 formed on a first side 18 thereof;

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- a sheet of non-static cling, flexible material 14 sized and shaped to only cover the entire first side 18 of the sheet of rigid material 12, the sheet of flexible material 14 temporarily adhered to the first side 18 of the sheet of rigid material 12 with surface adhesion only and configured to provide a planar surface that resists slipping on a material 50 and does not alter the first side 18 of the sheet of rigid material 12 when applied thereto or removed therefrom; and
- wherein the sheet of flexible material 14 comprises a plurality of sheet segments placed together on the first side 18 of the sheet of rigid material 12 to form a planar surface for bearing against the material 50.

McEligot lacks the sheet of flexible material being transparent.

With respect to the sheet of flexible material being transparent: Reber discloses a sticker 30 of flexible material, as shown in Fig. 11, said sticker 30 being transparent so it can be seen through when said sticker is placed over a sheet 11. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to make the sheet of flexible material 14 disclosed by McEligot of a transparent material as taught by Reber in order to be able to see through the material 14 and use the tool more accurately. Furthermore, the use of a transparent material to make the sheet of flexible material, absent any criticality, is only considered to be the use of a “ preferred ” or “ optimum ” material out of a plurality of well known materials that a person having ordinary skill in the art at the time the invention was made would have find obvious to provide using routine experimentation based, among other things, on

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the intended use of Applicant's apparatus, i.e., suitability for the intended use of Applicant's apparatus. See *In re Leshin*, 125 USPQ 416 (CCPA 1960) where the court stated that a selection of a material on the basis of suitability for intended use of an apparatus would be entirely obvious.

7. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over McEligot (U.S. 5,829,150) in view of Reber (U.S. 5,557,996).

McEligot discloses a method of making a tool 10, as shown in Fig. 1, including the steps of:

- providing a transparent sheet of rigid material 12 having first and second opposing planar sides and a plurality of lines 22 formed on one of the first and second opposing planar sides;
- providing a sheet of non-static cling, non-slip flexible material 14;
- sizing the sheet of flexible material 14 to substantially cover only one of the first and second opposing planar sides of the sheet of rigid material 12;
- placing the sized sheet of flexible material 14 on only one of the first and second opposing planar sides of the sheet of rigid material 12 to substantially cover only the one side of the sheet of rigid material 12 and to provide a removable non-slip bearing surface between the sheet of rigid material 12 and the material 50 to be measured and marked, the flexible material 14 adhering to the sheet of rigid material 12 by surface

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adhesion only to remain in place when facing downward and to be removed from the sheet of rigid material 12 without altering the sheet of rigid material 12 and the flexible material 14;

- wherein sizing the sheet of flexible material 14 comprises forming a plurality of sheet segments of the sheet of flexible material 14 to substantially cover only one side of the sheet of rigid material 12; and
- wherein the plurality of lines 22 are formed on the first planar side 18 of the sheet of rigid material 12 and the sheet of flexible material 14 is placed over the first side of the sheet of rigid material 12.

McEligot lacks the sheet of flexible material being transparent.

With respect to the sheet of flexible material being transparent: Reber discloses a sticker 30 of flexible material, as shown in Fig. 11, said sticker 30 being transparent so it can be seen through when said sticker is placed over a sheet 11. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to make the sheet of flexible material 14 disclosed by McEligot of a transparent material as taught by Reber in order to be able to see through the material 14 and use the tool more accurately. Furthermore, the use of a transparent material to make the sheet of flexible material, absent any criticality, is only considered to be the use of a “ preferred ” or “ optimum ” material out of a plurality of well known materials that a person having ordinary skill in the art at the time the invention was made would have find obvious to provide using routine experimentation based, among other things, on



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the intended use of Applicant's apparatus, i.e., suitability for the intended use of Applicant's apparatus. See *In re Leshin*, 125 USPQ 416 (CCPA 1960) where the court stated that a selection of a material on the basis of suitability for intended use of an apparatus would be entirely obvious.

8. Claims 7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over McEligot (U.S. 5,829,150) in view of Reber (U.S. 5,557,996).

McEligot discloses a method of making a tool 10, as shown in Fig. 1, including the steps of:

- providing a transparent sheet of rigid material 12 having first and second opposing planar sides and a plurality of lines 22 formed on one of the first and second opposing planar sides;
- providing a sheet of non-static cling, non-slip flexible material 14;
- sizing the sheet of flexible material 14 to substantially cover only one of the first and second opposing planar sides of the sheet of rigid material 12;
- placing the sized sheet of flexible material 14 on only one of the first and second opposing planar sides of the sheet of rigid material 12 to substantially cover only the one side of the sheet of rigid material 12 and to provide a removable non-slip bearing surface between the sheet of rigid material 12 and the material 50 to be measured and marked, the flexible material 14 adhering to the sheet of rigid material 12 by surface

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adhesion only to remain in place when facing downward and to be removed from the sheet of rigid material 12 without altering the sheet of rigid material 12 and the flexible material 14; and

- wherein the plurality of lines 22 are formed on the second side 18 of the sheet of rigid material 12 and the sheet of flexible material 14 is placed on the first side 16 of the sheet of rigid material 12.

McEligot lacks the sheet of flexible material being transparent.

With respect to the sheet of flexible material being transparent: Reber discloses a sticker 30 of flexible material, as shown in Fig. 11, said sticker 30 being transparent so it can be seen through when said sticker is placed over a sheet 11. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to make the sheet of flexible material 14 disclosed by McEligot of a transparent material as taught by Reber in order to be able to see through the material 14 and use the tool more accurately. Furthermore, the use of a transparent material to make the sheet of flexible material, absent any criticality, is only considered to be the use of a “ preferred ” or “ optimum ” material out of a plurality of well known materials that a person having ordinary skill in the art at the time the invention was made would have find obvious to provide using routine experimentation based, among other things, on the intended use of Applicant's apparatus, i.e., suitability for the intended use of Applicant's apparatus. See *In re Leshin*, 125 USPQ 416 (CCPA 1960) where the court stated that a selection

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of a material on the basis of suitability for intended use of an apparatus would be entirely obvious.

9. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over McEligot (U.S. 5,829,150).

McEligot discloses a tool 10, as shown in Fig. 1, having:

- a sheet of rigid material 14 having first and second opposing planar sides;
- a sheet of non-static cling, flexible material 12 having first and second opposing sides, the sheet of flexible material 12 sized and shaped to cover the entire first side of the sheet of rigid material 14, the sheet of flexible material 12 having a plurality of lines 22 formed on one of the first and second opposing sides, and the sheet of flexible material 12 adhering to the first side of the sheet of rigid material 14 with surface adhesion only and configured to provide a removable non-slip surface between the sheet 14 and a material 50 and to not alter the flexible material 12 and the sheet of rigid material 14 when the flexible material 12 is applied to and removed from the sheet of rigid material 14;
- wherein the sheet of flexible material 12 comprises a plurality of sheet segments placed together on the sheet of rigid material 14; and
- wherein the sheet of flexible material 12 has the lines 22 formed on the first side 18 thereof, and the sheet of flexible material 12 is placed on the sheet of rigid material

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14 such that the first side 18 of the sheet of flexible material 12 bears against the first side of the sheet of rigid material 14.

McEligot lacks the sheet of rigid material being transparent.

With respect to the sheet of rigid material being transparent: McEligot discloses a tool having a sheet of rigid material. The specific material claimed by applicant, i.e., transparent, absent any criticality, is only considered to be the use of a “ preferred ” or “ optimum ” material out of a plurality of well known materials that a person having ordinary skill in the art at the time the invention was made would have found obvious to provide using routine experimentation based, among other things, on the intended use of Applicant’s apparatus, i.e., suitability for the intended use of Applicant’s apparatus. See *In re Leshin*, 125 USPQ 416 (CCPA 1960) where the court stated that a selection of a material on the basis of suitability for intended use of an apparatus would be entirely obvious. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to make the sheet of rigid material 14 disclosed by McEligot of a transparent material in order to be able to see through the material 14 and use the tool more accurately.

10. Claims 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over McEligot (U.S. 5,829,150).

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McEligot discloses a tool 10, as shown in Fig. 1, having:

- a sheet of rigid material 14 having first and second opposing planar sides;
- a sheet of non-static cling, flexible material 12 having first and second opposing sides, the sheet of flexible material 12 sized and shaped to cover the entire first side of the sheet of rigid material 14, the sheet of flexible material 12 having a plurality of lines 22 formed on one of the first and second opposing sides, and the sheet of flexible material 12 adhering to the first side 16 of the sheet of rigid material 14 with surface adhesion only and configured to provide a removable non-slip surface between the sheet 14 and a material 50 and to not alter the flexible material 12 and the sheet of rigid material 14 when the flexible material 12 is applied to and removed from the sheet of rigid material 14; and
- wherein the sheet of flexible material 12 has the plurality of lines 22 formed on the second side 18, and the sheet of flexible material 12 has the first side 16 placed against the first side of the sheet of rigid material 14.

McEligot lacks the sheet of rigid material being transparent.

With respect to the sheet of rigid material being transparent: McEligot discloses a tool having a sheet of rigid material. The specific material claimed by applicant, i.e., transparent, absent any criticality, is only considered to be the use of a “ preferred ” or “ optimum ” material out of a plurality of well known materials that a person having ordinary skill in the art at the time the invention was made would have find obvious to provide using routine experimentation based,

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among other things, on the intended use of Applicant's apparatus, i.e., suitability for the intended use of Applicant's apparatus. See *In re Leshin*, 125 USPQ 416 (CCPA 1960) where the court stated that a selection of a material on the basis of suitability for intended use of an apparatus would be entirely obvious. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to make the sheet of rigid material 14 disclosed by McEligot of a transparent material in order to be able to see through the material 14 and use the tool more accurately.

11. Claims 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over McEligot (U.S. 5,829,150) in view of Reber (U.S. 5,557,996).

McEligot discloses a tool 10, as shown in Fig. 1, having:

- a transparent sheet of rigid material 12 having opposing first and second sides with a plurality of lines 22 formed on one of the first and second sides;
- a sheet of non-static cling, flexible material 14 removably adhered to only one of the first and second sides of the sheet of rigid material 12 to provide a planar, non-slip surface between the transparent sheet of rigid material 12 and a material 50 to be measured and marked and to not alter the sheet of rigid material 12 when the sheet of flexible material 14 is applied thereto or removed therefrom;
- wherein the sheet of flexible material 14 is adhered to the side 18 of the sheet of rigid material 12 on which the plurality of lines 22 are formed;

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- wherein the sheet of flexible material 14 is adhered to the side 16 of the sheet of rigid material 12 that does not have the plurality of lines 22 formed thereon; and
- wherein the sheet of flexible material 14 is formed of multiple segments.

McEligot lacks the sheet of flexible material being transparent.

With respect to the sheet of flexible material being transparent: Reber discloses a sticker 30 of flexible material, as shown in Fig. 11, said sticker 30 being transparent so it can be seen through when said sticker is placed over a sheet 11. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to make the sheet of flexible material 14 disclosed by McEligot of a transparent material as taught by Reber in order to be able to see through the material 14 and use the tool more accurately. Furthermore, the use of a transparent material to make the sheet of flexible material, absent any criticality, is only considered to be the use of a “ preferred ” or “ optimum ” material out of a plurality of well known materials that a person having ordinary skill in the art at the time the invention was made would have find obvious to provide using routine experimentation based, among other things, on the intended use of Applicant’s apparatus, i.e., suitability for the intended use of Applicant’s apparatus. See *In re Leshin*, 125 USPQ 416 (CCPA 1960) where the court stated that a selection of a material on the basis of suitability for intended use of an apparatus would be entirely obvious.

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12. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over McEligot (U.S. 5,829,150).

McEligot discloses a tool 10, as shown in Fig. 1, having:

- a transparent sheet of non-static cling, flexible material 12 having opposing first and second sides with a plurality of lines 22 formed on one of the first and second sides;
- a sheet of rigid material 14 having opposing first and second sides with the sheet of flexible material 12 removably adhered by surface adhesion only to only one of the first and second sides to provide a planar, non-slip surface between the sheet of rigid material 14 and a material 50 to be measured and marked and to not alter either one of the sheet of flexible material 12 and the sheet of rigid material 14 when adhered together or removed apart.

McEligot lacks the specific material of the sheet of flexible material, and the sheet of rigid material being transparent.

With respect to the specific material of the sheet of flexible material and the sheet of rigid material being transparent: McEligot discloses a tool having a transparent sheet of flexible material 12 made of some material and a sheet of rigid material 14. The specific materials claimed by applicant, i.e., vinyl material having plasticizers therein, and transparent, absent any criticality, are only considered to be the use of a “ preferred ” or “ optimum ” materials out of a plurality of well known materials that a person having ordinary skill in the art at the time the



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invention was made would have find obvious to provide using routine experimentation based, among other things, on the intended use of Applicant's apparatus, i.e., suitability for the intended use of Applicant's apparatus. See *In re Leshin*, 125 USPQ 416 (CCPA 1960) where the court stated that a selection of a material on the basis of suitability for intended use of an apparatus would be entirely obvious. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to make the sheet of rigid material 14 disclosed by McEligot of a transparent material in order to be able to see through the material 14 and use the tool more accurately. Furthermore, it would have been obvious to make the sheet of flexible material/ruler 12 of a vinyl material having plasticizers since it is well known in the art the use of plastics to make rulers.

13. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over McEligot (U.S. 5,829,150) in view of Reber (U.S. 5,557,996).

McEligot discloses a tool 10, as shown in Fig. 1, having:

- a transparent sheet of rigid material 12 having a plurality of lines 22 formed on a first side 18 thereof; and
- a sheet of non-static cling, flexible material 14 removably adhered to the first side 18 of the sheet of rigid material 12 with surface adhesion only and configured to provide a planar surface that resists slipping on a material 50 to be measured and marked and

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does not alter the first side 18 of the sheet of rigid material 12 when applied thereto or removed therefrom.

McEligot lacks the sheet of flexible material being transparent and having plasticizers that continually migrate to surfaces of the sheet of flexible material.

With respect to the sheet of flexible material being transparent and having plasticizers that continually migrate to surfaces of the sheet of flexible material: Reber discloses a sticker 30 of flexible material, as shown in Fig. 11, said sticker 30 being transparent so it can be seen through when said sticker is placed over a sheet 11. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to make the sheet of flexible material 14 disclosed by McEligot of a transparent material as taught by Reber in order to be able to see through the material 14 and use the tool more accurately. Furthermore, the specific materials claimed by applicant, i.e., transparent and having plasticizers that continually migrate to surfaces of the sheet of flexible material, absent any criticality, are only considered to be the use of a “ preferred ” or “ optimum ” materials out of a plurality of well known materials that a person having ordinary skill in the art at the time the invention was made would have find obvious to provide using routine experimentation based, among other things, on the intended use of Applicant’s apparatus, i.e., suitability for the intended use of Applicant’s apparatus. See *In re Leshin*, 125 USPQ 416 (CCPA 1960) where the court stated that a selection of a material on the basis of suitability for intended use of an apparatus would be entirely obvious. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was

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made to make the sheet of flexible material 14 of a material having plasticizers that continually migrate to surfaces of the sheet of flexible material, since McEligot is suggesting the use of a variety of materials, such as plastic, to make the sheet 14.

14. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over McEligot (U.S. 5,829,150).

McEligot discloses a tool 10, as shown in Fig. 1, having:

- a transparent sheet of rigid material 12 having first and second opposing planar sides and a plurality of lines 22 formed on one of the first and second opposing planar sides; and
- a sheet of non-static cling flexible material 14 formed of a vinyl material, the sheet of flexible material 14 adhering to the first side of the sheet of rigid material 12 by surface adhesion only and configured to provide a planar, non-slip surface and to leave no adhesive on the first side of the sheet of rigid material 12 when removed therefrom.

McEligot lacks the sheet of flexible material having plasticizers that continually migrate to surfaces of the sheet of flexible material.

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With respect to the sheet of flexible material having plasticizers that continually migrate to surfaces of the sheet of flexible material: McEligot discloses a tool having a sheet of flexible material 14 formed of a vinyl material. The specific material claimed by applicant, i.e., having plasticizers that continually migrate to surfaces of the sheet of flexible material, absent any criticality, is only considered to be the use of a “ preferred ” or “ optimum ” materials out of a plurality of well known materials that a person having ordinary skill in the art at the time the invention was made would have find obvious to provide using routine experimentation based, among other things, on the intended use of Applicant’s apparatus, i.e., suitability for the intended use of Applicant’s apparatus. See In re Leshin, 125 USPQ 416 (CCPA 1960) where the court stated that a selection of a material on the basis of suitability for intended use of an apparatus would be entirely obvious.

15. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over McEligot (U.S. 5,829,150).

McEligot discloses a tool 10, as shown in Fig. 1, having:

- a sheet of rigid material 14 having first and second opposing planar sides; and
- a sheet of non-static cling, flexible material 12 having first and second opposing sides, the sheet of flexible material 12 having a plurality of lines 22 formed on one of the first and second opposing sides and adhering to the first side of the sheet of rigid material 14 with surface adhesion only and configured to provide a removable non-

slip surface between the sheet 14 and a material 50 to be measured and marked and to not alter the flexible material 12 in the sheet of rigid material 14 when the flexible material 12 is applied to and removed from the sheet of rigid material 14.

McEligot lacks the sheet of rigid material being transparent, and the specific material of the sheet of flexible material.

With respect to the sheet of rigid material being transparent, and the specific material of the sheet of flexible material: McEligot discloses a tool having a sheet of rigid material 14, and a sheet of flexible material 12, each sheet being made of some material. The specific materials claimed by applicant, i.e., the sheet of rigid material being transparent, and the sheet of flexible material formed of a top coated highly-plasticized cling vinyl film having plasticizers that continually migrate to a surface of each of the first and second opposing sides, absent any criticality, are only considered to be the use of a “ preferred ” or “ optimum ” materials out of a plurality of well known materials that a person having ordinary skill in the art at the time the invention was made would have find obvious to provide using routine experimentation based, among other things, on the intended use of Applicant’s apparatus, i.e., suitability for the intended use of Applicant’s apparatus. See *In re Leshin*, 125 USPQ 416 (CCPA 1960) where the court stated that a selection of a material on the basis of suitability for intended use of an apparatus would be entirely obvious.

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16. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over McEligot (U.S. 5,829,150) in view of Reber (U.S. 5,557,996).

McEligot discloses a tool 10, as shown in Fig. 1, having:

- a transparent sheet of rigid material 12 having opposing first and second sides with a plurality of lines 22 formed on one of the first and second sides; and
- a sheet of non-static cling, flexible material 14 formed from vinyl material, the flexible material 14 removably adhered to only one of the first and second sides of the sheet of rigid material 12 and providing a non-slip surface between the transparent sheet of rigid material 12 and a material 50 to be measured and marked, the flexible material 14 configured to not alter the transparent sheet of rigid material 12 when applied thereto and to not alter and leave an adhesive on the transparent sheet of rigid material 12 when removed therefrom.

McEligot lacks the sheet of flexible material being transparent and having plasticizers that continually migrate to a surface of the sheet of flexible material.

With respect to the sheet of flexible material being transparent and having plasticizers that continually migrate to a surface of the sheet of flexible material: Reber discloses a sticker 30 of flexible material, as shown in Fig. 11, said sticker 30 being transparent so it can be seen through when said sticker is placed over a sheet 11. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to make the sheet of

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flexible material 14 disclosed by McEligot of a transparent material as taught by Reber in order to be able to see through the material 14 and use the tool more accurately. Furthermore, the specific materials claimed by applicant, i.e., transparent and having plasticizers that continually migrate to surfaces of the sheet of flexible material, absent any criticality, are only considered to be the use of a “ preferred ” or “ optimum ” materials out of a plurality of well known materials that a person having ordinary skill in the art at the time the invention was made would have find obvious to provide using routine experimentation based, among other things, on the intended use of Applicant’s apparatus, i.e., suitability for the intended use of Applicant’s apparatus. See *In re Leshin*, 125 USPQ 416 (CCPA 1960) where the court stated that a selection of a material on the basis of suitability for intended use of an apparatus would be entirely obvious. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to make the sheet of flexible material 14 of a material having plasticizers that continually migrate to surfaces of the sheet of flexible material, since McEligot is suggesting the use of a variety of materials, such as vinyl and plastic, to make the sheet 14.

17. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over McEligot (U.S. 5,829,150).

McEligot discloses a tool 10, as shown in Fig. 1, having:

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- a transparent sheet of non-static cling, flexible material 12 having planar opposing first and second sides with a plurality of lines 22 formed on one of the planar first and second sides; and
- a sheet of rigid material 14 having opposing first and second sides with the sheet of flexible material 12 removably adhered by surface adhesion only to only one of the first and second sides to provide a non-slip surface between the sheet of rigid material 14 and the material to be measured and marked, the transparent sheet of flexible material 12 configured to not alter the sheet of rigid material 14 when applied thereto and removed therefrom.

McEligot lacks the sheet of rigid material being transparent, and the specific material of the sheet of flexible material.

With respect to the sheet of rigid material being transparent, and the specific material of the sheet of flexible material: McEligot discloses a tool having a sheet of rigid material 14, and a sheet of flexible material 12, each sheet being made of some material. The specific materials claimed by applicant, i.e., the sheet of rigid material being transparent, and the sheet of flexible material formed of vinyl material having plasticizers that continually migrate to a surface of the first and second sides, absent any criticality, are only considered to be the use of a “ preferred ” or “ optimum ” materials out of a plurality of well known materials that a person having ordinary skill in the art at the time the invention was made would have find obvious to provide using routine experimentation based, among other things, on the intended use of Applicant’s apparatus,



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i.e., suitability for the intended use of Applicant's apparatus. See *In re Leshin*, 125 USPQ 416 (CCPA 1960) where the court stated that a selection of a material on the basis of suitability for intended use of an apparatus would be entirely obvious.

18. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over McEligot (U.S. 5,829,150) in view of Reber (U.S. 5,557,996).

McEligot discloses a method of making a tool 10, as shown in Fig. 1, including the steps of:

- providing a transparent sheet of rigid material 12 having first and second opposing planar sides and a plurality of lines 22 formed on one of the first and second opposing planar sides;
- providing a sheet of non-static cling, non-slip flexible material 14; and
- placing the sheet of flexible material 14 on one of the first and second opposing planar sides of the sheet of rigid material 12 to provide a planar non-slip surface between the transparent sheet of rigid material 12 and a material 50 to be measured and marked, the sheet of flexible material 14 adhering to the sheet of rigid material 12 by surface adhesion only and to not leave adhesive material on the transparent sheet of rigid material 12 when removed therefrom.

McEligot lacks the sheet of flexible material being transparent.

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With respect to the sheet of flexible material being transparent: Reber discloses a sticker 30 of flexible material, as shown in Fig. 11, said sticker 30 being transparent so it can be seen through when said sticker is placed over a sheet 11. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to make the sheet of flexible material 14 disclosed by McEligot of a transparent material as taught by Reber in order to be able to see through the material 14 and use the tool more accurately. Furthermore, the use of a transparent material to make the sheet of flexible material, absent any criticality, is only considered to be the use of a “ preferred ” or “ optimum ” material out of a plurality of well known materials that a person having ordinary skill in the art at the time the invention was made would have found obvious to provide using routine experimentation based, among other things, on the intended use of Applicant's apparatus, i.e., suitability for the intended use of Applicant's apparatus. See *In re Leshin*, 125 USPQ 416 (CCPA 1960) where the court stated that a selection of a material on the basis of suitability for intended use of an apparatus would be entirely obvious.

19. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over McEligot (U.S. 5,829,150).

McEligot discloses a method of making a tool 10, as shown in Fig. 1, including the steps of:

- providing a sheet of flexible material 14 formed of vinyl film;

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- placing the sheet of flexible material 14 on one of first and second opposing planar sides of a sheet of rigid material 12 to form a planar non-slip surface between the sheet of rigid material 12 and a material 50 to be measured and marked, the sheet of flexible material 14 adhering to the sheet of rigid material 12 by surface adhesion only; and
- removing the sheet of flexible material 14 from the sheet of rigid material 12 without altering the sheet of rigid material 12 and without leaving adhesive on the sheet of rigid material 12.

McEligot lacks the sheet of flexible material having plasticizers that continually migrate to a surface of the film.

With respect to the sheet of flexible material having plasticizers that continually migrate to a surface of the film: McEligot discloses a tool having a sheet of flexible material 14 formed of a vinyl material. The specific material claimed by applicant, i.e., having plasticizers that continually migrate to surfaces of the sheet of flexible material, absent any criticality, is only considered to be the use of a “ preferred ” or “ optimum ” materials out of a plurality of well known materials that a person having ordinary skill in the art at the time the invention was made would have find obvious to provide using routine experimentation based, among other things, on the intended use of Applicant’s apparatus, i.e., suitability for the intended use of Applicant’s apparatus. See *In re Leshin*, 125 USPQ 416 (CCPA 1960) where the court stated that a selection

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of a material on the basis of suitability for intended use of an apparatus would be entirely obvious.

20. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over McEligot (U.S. 5,829,150) in view of Reber (U.S. 5,557,996).

McEligot discloses a method of making a tool 10, as shown in Fig. 1, including the steps of:

- providing a sheet of non-slip flexible material 14;
- marking the sheet of flexible material 14 for a visual aid; and
- placing the sheet of flexible material 14 on one of first and second opposing planar sides of a sheet of rigid material 12 to provide a non-slip planar surface between the sheet of rigid material 12 and a material 50 to be measured and marked.

McEligot lacks the sheet of flexible material being transparent.

With respect to the sheet of flexible material being transparent: Reber discloses a sticker 30 of flexible material, as shown in Fig. 11, said sticker 30 being transparent so it can be seen through when said sticker is placed over a sheet 11. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to make the sheet of flexible material 14 disclosed by McEligot of a transparent material as taught by Reber in order

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to be able to see through the material 14 and use the tool more accurately. Furthermore, the use of a transparent material to make the sheet of flexible material, absent any criticality, is only considered to be the use of a “ preferred ” or “ optimum ” material out of a plurality of well known materials that a person having ordinary skill in the art at the time the invention was made would have find obvious to provide using routine experimentation based, among other things, on the intended use of Applicant’s apparatus, i.e., suitability for the intended use of Applicant’s apparatus. See *In re Leshin*, 125 USPQ 416 (CCPA 1960) where the court stated that a selection of a material on the basis of suitability for intended use of an apparatus would be entirely obvious.

### ***Response to Arguments***

21. Applicant's arguments with respect to claims 1-27 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

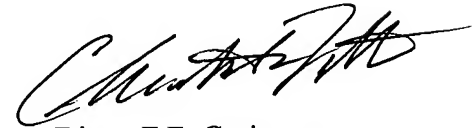
22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeline Gonzalez whose telephone number is (571) 272-2243. The examiner can normally be reached on Monday-Friday (8:00-5:30), alternate Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F.F. Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MG



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